

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board
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4 UNITED STATES PATENT AND TRADEMARK OFFICE
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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
9

10
11 *Ex parte* IAN PEEK
12

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14 Appeal 2006-3098
15 Application 10/762,413¹
16 Technology Center 3700
17

18
19 Decided: March 26, 2007
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21
22 *Before:* JENNIFER D. BAHR, STUART S. LEVY, and ROBERT E.
23 NAPPI, *Administrative Patent Judges.*
24

25 LEVY, *Administrative Patent Judge.*
26

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28 DECISION ON APPEAL
29

30 STATEMENT OF CASE

31 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection
32 of claim 11. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

33 Appellant invented a golf training apparatus (Specification 3). In
34 particular, the invention resides in a golf apparatus for practicing straight

¹ Application filed January 22, 2004. The real party in interest is Mr. Yan Peek.

1 hits with a rack, which has a rod aligned horizontally and parallel to the
2 desired hitting direction. The rod is fastened to a rack at a distance to the
3 rack, such that the golf club may be swung through underneath the rod. The
4 training apparatus is also suited for the short game, i.e., for shorter
5 approaching hits (*id.*).

6 The only claim under appeal reads as follows:

7 11. A golf training apparatus for practicing straight hits,
8 comprising:

9 an upright rack made of a rigid material; and
10 a rod provided on said upright rack and aligned substantially horizontally
11 and parallel to a desired hitting direction, said rod being arranged at a
12 distance to said upright rack such that a golf club is swingable through
13 underneath said rod, and while said rack being rigid said rod being inflatable
14 such that touching said inflatable rod by a golfer is harmless and not
15 accompanied by a risk of injuries.

16
17 The Examiner rejected claim 11 under 35 U.S.C. § 103(a) (2004).

18 The prior art relied upon by the Examiner in rejecting the claims on
19 appeal is:

20 Elson 3,768,501 Oct. 30, 1973

21
22 Appellant contends that the claimed subject matter would not have
23 been obvious. More specifically, Appellant contends that Elson deals with a
24 valve for inflating balloons, and is therefore non-analogous art. It is argued
25 (Br. 5) that Elson is not from the same field of endeavor as the golf training
26 apparatus of the present invention and that Elson is directed to an improved
27 inflation mechanism, which is not reasonably pertinent to the particular
28 problem with which the inventor of the present invention is involved. The

1 Examiner contends (Answer 3) that in Elson's "inflatable balloon element 10
2 fails to be in a rod shape." The Examiner asserts that it is known to make
3 balloons in a cylindrical shape and that the intended use of the apparatus
4 does not differentiate the claimed apparatus from the prior art, and that
5 Elson's device is capable of being used as a training device.

6 We reverse.

7 ISSUE

8 Has Appellant shown that the Examiner has failed to establish a prima
9 facie case of obviousness of claim 11 as being unpatentable over Elson?

10 The issue turns on whether Elson is analogous art.

11
12 FINDINGS OF FACT

13 1. Appellant invented a golf training apparatus (Specification 2).

14 2. 85% of golfers swing the ball from outside to inside. Executing a
15 swing from outside to inside is called a slice. An exact direction of flight is
16 only obtained if the club is guided in a plane in the intended direction of the
17 flight of the ball (*id.*).

18 3. Elson is directed to an improved inflation valve mechanism for
19 balloons and similar low pressure inflation devices (col. 1, ll. 43-45).

20 4. As shown in Fig. 1, element 10 of Elson represents a conventional
21 inflatable balloon (col. 3, l. 25).

22 5. Tank 33 contains compressed helium (col. 4, l. 23).
23

1 PRINCIPLES OF LAW

2 On appeal, Appellant bears the burden of showing that the Examiner
3 has not established a prima facie case of non-obviousness. See *In re Kahn*,
4 441 F.3d 977, 987-988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *DyStar*
5 *Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick, Co.*, 464 F.3d
6 1356, 1360-1361, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006).

7 The test for non-analogous art is first whether the art is within the
8 field of the inventor's endeavor and, if not, whether it is reasonably pertinent
9 to the problem with which the inventor was involved. *In re Wood*, 599 F.2d
10 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably
11 pertinent if, even though it may be in a different field of endeavor, it
12 logically would have commended itself to an inventor's attention in
13 considering his problem because of the matter with which it deals. *In re*
14 *Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992).

15
16 ANALYSIS

17 If the rejection were under 35 U.S.C. § 102(e) we would have agreed
18 with the Examiner that the intended use of the structure would not
19 differentiate the claimed apparatus from the applied prior art. However, as
20 noted by the Examiner, Elson does not describe all of the limitations of
21 claim 11 because Elson does not disclose the balloon to be in a rod shape.
22 As a result, the Examiner rejects the claim under 35 U.S.C. § 103(a) on the
23 basis that it would have been obvious to have used a cylindrical shaped
24 balloon as the inflatable rod. However, in order to modify the reference to
25 meet the claimed invention, it is necessary that the reference be analogous

1 art. From our review of the record, we agree with the Appellant (Br. 4) that
2 Elson is not analogous art for the following reasons.

3 Elson is directed to a valve mechanism for inflating balloons. The
4 valve mechanism is not in the same field of endeavor as a golf training aid.
5 In addition, because Elson is directed to a valve for inflating balloons, Elson
6 is not reasonably related to the problem Appellant is directed to, i.e., a
7 training apparatus for practicing straight hits of a golf ball. Since Elson is
8 not analogous art it would not have been obvious to modify Elson to arrive
9 at the claimed invention.

10
11 CONCLUSION OF LAW

12 On the record before us, Appellant has shown that the Examiner erred
13 in holding that Elson would have suggested to an artisan the invention of
14 claim 11.

15 DECISION

16 The Examiner's rejection of claim 11 is reversed.

17
18 REVERSED

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25 JRG

Appeal 2006-3098
Application 10/762,413

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